



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/000,924	12/30/97	HASEBE	T 1083.1048/JD

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WASHINGTON DC 20001

TM02/0410

EXAMINER

NGUYEN, C

ART UNIT

PAPER NUMBER

2165

DATE MAILED:

04/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/000,924

Applicant(s)
Hasebe et al.

Examiner
Cuong H. Nguyen

Group Art Unit
2165



☒ Responsive to communication(s) filed on Mar 22, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-23 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-23 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

1. This Office Action is the facsimile communication received on 3/22/2001.
2. Claims 1-23 are pending in this application. Claim 23 is requested to be added.

Election/Restriction

3. After further consideration, the election to one of the following invention is deemed necessary. The delay of this requirement is regretted by the examiner of record.
4. Restriction to one of the following inventions is required under 35 U.S.C. § 121;

I. Claims 1-3, 4-8, 9-11, 12-14, 15-17, 18, 20, 22, and 23, drawn to a system for protecting input data requiring authorization for use during utilization of the input data, classified in US class 713, subclass 189.

II. Claims 19, 21, drawn to a method of processing input data requiring authorization for use, classified in class 705, subclass 51.

5. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if

either of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product, e.g., a method of processing input data requiring authorization for use in online commercial database searching using a host server.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicants is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR § 1.143).

7. The following rejections are based on the examiner's broadest reasonable interpretation of the claims, *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention.

Claim 20 is rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention. Since there is no preamble in the introductory part of these claims. The examiner submits that statements in this claim about intended uses, capabilities, and structures, or structural relationships, as positive structural limitations; these claims are not particularly pointed out and distinctly claimed within the meaning of section 112 because of lacking preamble statements. The applicants should be aware of the necessity for limiting their claims. In this sense, these claims fail to comply with section 112, 2nd para., in failing distinctly to claim what is his actual invention. "There is no positive recitation of any structural cooperation among the element listed", this rejection is in fact based on the ground that the claims are incomplete, and therefore,

indefinite and in this way do not conform to the requirement of 35 U.S.C. § 112.

9. Note: Also, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

- The phrase of "what kind of processing has been applied by said processing unit to the generated data, which includes the input data, as being processed, in the compound data" is not weighted much because the claim (e.g. claim 20) is about "a device", that contains a saving unit storing information. This "storing means" has a weight in the claim, not the containing information of "indicating what kind of processing has been applied by said processing unit to the generated data, which includes the input data, as being processed, in the

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compound data"; furthermore, "what kind of processing" is indefinite.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Monday-Friday from 7:00 AM-3:30 PM.

Any response to this action should be mailed to:

Amendments

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

Or: (703) 305-0040 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the

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Group receptionist whose telephone number is (703) 305-3900.

Cuong H. Nguyen

Cuong H. Nguyen

Patent Examiner

Mar. 23, 2001